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EXAMINER

STCYR, D #8

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/10/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/783,372**

Applicant(s)  
**Martin Finsterwald**

Examiner  
**Daniel St.Cyr**

Group Art Unit  
**2876**



☒ Responsive to communication(s) filed on Jan 13, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-37 and 39-42 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-37 and 39-42 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of <sup>substitute</sup> Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☒ Notice of <sup>substitute</sup> Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Specification*

1. Applicant has failed to include the appropriate headings, such as "Background of the Invention," "Brief Description of the Drawings," etc. Correction should be made in the next response.
2. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because the specification is formatted with a very small font and the printing is illegible.
3. A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

### *Claim Objections*

4. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).
5. Claims 1-37 are objected to because of the following informalities: the language of the claims is very difficult to understand, it appears to be a literal translation from a foreign language.

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A substitute set of claims in proper idiomatic English is required. Appropriate correction is required.

6. Claims 26 and 35 are objected to because of the following informalities: "in accordance with one of the preceding claims" should be deleted. Appropriate correction is required.

In claim 26, line 6.

In claim 35, line 5.

***Claim Rejections - 35 U.S.C. § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17, 24, 25, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 24 recites the broad recitation communication network, and the claim also recites particularly via Internet which is the narrower statement of the range/limitation.

***Claim Rejections - 35 U.S.C. § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. As best understood, claims 1-16, 18-23, 26-30, and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Deaton et al, US Patent No. 5,592,560, cited by the applicant.

Deaton et al disclose a method and system for building a database and performing marketing based upon prior shopping history wherein the database includes a customer's data (see col. 9, lines 1-3). The customer's checking account and the transit number serve as a special code in the customer's data (see col. 11, lines 8-14 and col. 13, lines 1-3).

Re claims 3 and 4, additional information relating to the service is stored in data collecting station before acquisition of the service (see col. 20, line 24 +).

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Re claims 5 and 16, additional, such as phone number, information is contained in the code (col. 14, line 31-43).

Re claim 6, it is inherent that the customer's code is stored in the database on the first time that it was received.

Re claims 7 and 8, wherein the codes which can be transmitted within a specific time interval can be distinguished from one another is inherent.

Re claims 11 and 12, the customer's code consists of machine readable code (see the abstract).

Re claim 13, the records having the code are formed as invoices printed out by a computer (see figure 2A)

Re claim 14, at least a part of the customer's code is formed by commercially customary bar code price label (see figure 2C and col. 10, line 42 +).

Re claim 15, the customer's code is arranged at a position of a product package and is in particular printed thereon (see figure 2C).

Re claim 18, the time of the code transmission is stored in the data collecting station (see col. 20, line 35 +).

Re claim 19, when a customer first makes contact with the data collecting station, customer-specific data, in particular the code is allotted to the customer (see col. 7, lines 62 +).

The customer's bank check account number serves as a customer code.

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Re claim 20, the data collecting station identifies the customer on further contacts which take place after the first contact has been made with the reference to the characteristic number (see col. 7, line 65 to col. 8, line 12).

Re claim 21, once a customer is registered into the system, the second time contact is made, the customer's information including the customer's code is transmitted to the data collecting station.

Re claims 22, 23, and 25, the customer, after acquired a specific number of services, receives a coupon from the coupon dispenser as a reward wherein the reward depends on the stored data in the database (see figure 2C and abstract).

Re claims 26 and 27, the system of Deaton et al inherently includes an apparatus for the marking of a product wherein the marking is laid out in such a way that the code can be applied to a position of the finish product.

Re claims 28 and 34, a printing mechanism is inherently included for printing out customers' information, such as receipt of purchased including the price and date.

Re claim 33, the data transmission takes place within a predetermined time frame (see col. 20, line 35 +).

***Claim Rejections - 35 U.S.C. § 103***

12. Claims 9-10 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al in view of Storch et al, US Patent No. 5,367,148. Deaton et al have discussed above.

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Deaton et al fail to disclose or fairly suggest that the customer's code includes a random selected portion wherein each random generated code is distinct.

Storch et al disclose a counterfeit detection using ID numbers with at least one random portion. The ID number includes the serial number of the product and at least one random number generated. (See figures 1-3; and col. 10, lines 36-54).

It would have been obvious for a person of ordinary skill in the art, at the time the invention was made, to employ the random generated number technique of Storch et al to the check number of Deaton et al in order to securely identify each customer. Such modification would provide Deaton et al with a security system for preventing fraud, in an event of an unauthorized individual attempts to access his/her account etc. Accordingly, such modification would have been an obvious extent as taught by Deaton et al, and therefore an obvious expedient.

13. Claims 17, 24-25, 31, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al in view of Bezos, US Patent No. 5,727,163. Deaton et al have been discussed above.

Deaton et al fail to disclose or fairly suggest that the customer accesses the account via the Internet for checking the status of the account and the code of the product remain invisible until the product is purchased.

Bezos disclose a secure method for communicating credit card data when placing an order on a non-secure network wherein the customer can access the remote merchant location using the



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Internet (see figure 1; and the abstract). Bezos also discloses that the code may be concealed with latex covering which serves as a means for keeping the code invisible (see col. 13, lines 58-65).

Re claim 40, by buying goods or services through the Internet, the customer receives a conformation number which can easily print and serve as a receipt.

It would have been obvious for a person of ordinary skill in the art, at the time the invention was made, to employ the Internet connection of Bezos to the teaching of Deaton et al in order to have a more convenient, more practical interface for accessing the customer account. Furthermore, the above identified communication means is considered to be an art recognized equivalent interface for accessing information. Therefore such modification would have been an obvious expedient, well within the ordinary skill in the art

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gunn, US Patent No. 4,024,380, discloses a self service postal apparatus and method. Creekmore, Patent No. 4,109,238, discloses an apparatus for verifying checks presented for acceptance. Zetmeir, Patent No. 4,752,675, discloses a method of collecting response data from direct mail advertising. Roach et al, Patent No. 5,310,997, disclose an automated order and delivery system. Gupta, Patent No. 5,382,779, discloses a shelf price label verification apparatus and method. Campo et al, Patent No. 5,408,077, disclose a portable point of sale terminal. Beller et al, Patent No. 5,602,377, disclose a bar code dataform scanning and labeling apparatus and method. Newman et al, Patent No. 5,665,951, disclose a customer indicia storage and utilization

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system. Mazzamuto et al, Patent No. 5,665,953, disclose a self-contained personal data collector for redeeming coupons.

Papers related to this application may be submitted to Group 2500 by facsimile transmission. Papers should be faxed to Group 2500 via PTO fax machine located at Crystal plaza 2. The fax number is **(703)308-7722**.

Any inquiry concerning this communication from the examiner should be directed to **Daniel St.Cyr** whose telephone number is **(703) 305-2656**. The examiner can normally be reached between the hours of **8:00AM to 4:30PM** Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Anita Gross**, can be reached at **(703) 308-4869**.

Any inquiry of general nature relating to the status of this application should be directed to the group receptionist whose telephone is **(703)308-0956**.



**ANITA PELLMAN GROSS  
PRIMARY EXAMINER  
GROUP 2800**

July 1, 1998

DS